

REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on September 12, 2005, the Examiner rejected claims 21-29, 31-38, 40-41 under 35 U.S.C. §103(a) as being unpatentable over Evans (U.S. Patent No. 5,924,074, hereinafter "Evans") in view of Feldon et al. (U.S. Patent No. 5,732,221, hereinafter "Feldon") in view of Lavin et al. (U.S. Patent No. 5,772,585, hereinafter "Lavin") and further in view of Provost et al. (U.S. Patent No. 6,341,265, hereinafter "Provost"). Applicant expresses appreciation for the Examiner's Interview held on March 1, 2006, and respectfully provides the following:

The standard for a Section 103 rejection is set for in M.P.E.P 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

Applicant respectfully submits that the references cited by the Examiner do not teach or suggest the limitations claimed in the present invention. In particular, independent claims 21, 33 and 42 as provided herein include limitations relating to generating the customizable form by defining display specifications that relate to a display of the healthcare procedures characteristically performed by the particular healthcare provider and the healthcare diagnoses characteristically employed by the particular healthcare provider, wherein the display specifications are based on individual user preferences, and wherein said step for generating the customizable form comprises: selecting a customizable form definition operation from a set-up

menu; displaying a form header window that identifies the customizable form by identification and description, and provides a current status of the customizable form; determining if an other form will be used to generate the customizable form; wherein if the other form is used, selecting the other form, displaying the customizable form in a definition window, and populating the customizable form with information from the other form; wherein if the other form is not used, defining a new structure for the customizable form, selecting a number of rows for inclusion into the customizable form, defining specifications relating to the pool of healthcare procedures and to the one or more healthcare diagnoses, and displaying the customizable form in a definition window; and determining a particular sequence of the pool of healthcare procedures based upon user preferences. These limitations are supported by the disclosure as originally filed. For example, reference is made to Figures 3A, 3B, 4A, 4B, 4C, 5, 6 and 12, and the corresponding discussion of the application as originally filed.

In contrast, none of the references cited by the Examiner, alone or in combination, teaches or suggests such limitations. And, since the references cited by the Examiner do not teach or suggest each and every limitation of the independent claims, Applicant respectfully submits that the prior art references do not make obvious the independent claims for at least the reasons provided herein. Furthermore, since the prior art references do not make obvious the independent claims, Applicant respectfully submits that the prior art references cited by the Examiner do not make obvious the corresponding dependent claims, which provide further limitations to otherwise allowable subject matter.

Accordingly, Applicant respectfully submits that the claim set as provided herein overcomes all rejections made by the Examiner in the Office Action.

CONCLUSION

Applicant respectfully submits that the claim set provided herein does not add new matter and is now in condition for allowance. Accordingly, Applicant therefore requests favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

Dated this 13th day of March, 2006.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'B. Broadbent', with a stylized flourish at the end.

Berne S. Broadbent
Attorney for Applicant
Registration No. 30,550

KIRTON & McCONKIE
1800 Eagle Gate Tower
60 East South Temple
Salt Lake City, Utah 84111
Telephone: (801) 323-5986
Facsimile: (801) 321-4893